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From: Carrie Parker Legal Assistant to Wayne Bailey	No. of Pages Including Cover Sheet: **30**

Message:

Enclosed herewith:

• Transmittal Document; and
• Appeal Brief.

Re: Application No. 09/827,431
  Attorney Docket No: CA920000034US1

Date: Monday, January 31, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Albazz et al.**	§	Group Art Unit: **3621**
	§	
Serial No.: **09/827,431**	§	Examiner: **Elisca, Pierre E.**
	§	
Filed: **April 6, 2001**	§	Attorney Docket No.: **CA920000034US1**
	§	
For: **System and Method for**	§	
Generating a Contract and	§	
Conducting Contractual Activities	§	
Under the Contract	§	

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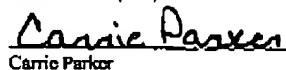
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•   Appeal Brief (37 C.F.R. 41.37).

A fee of $500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0461. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

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Docket No. CA920000034US1   *PATENT*

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on November 30, 2004.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-48

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 15, 18, 28, 37 and 47
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-14, 16, 17, 19-27, 29-36, 38-46 and 48
4. Claims allowed: none
5. Claims rejected: 1-14, 16, 17, 19-27, 29-36, 38-46 and 48

C. CLAIMS ON APPEAL

The claims on appeal are: 1-14, 16, 17, 19-27, 29-36, 38-46 and 48

STATUS OF AMENDMENTS

An amendment after final was filed by Appellants on October 27, 2004. The status of such amendment is unknown, as the advisory action dated 11/23/2004 did not indicate whether such amendment would be entered. However, this amendment did not amend any claims, but merely argued that the rejection of all pending claims was in error.

SUMMARY OF CLAIMED SUBJECT MATTER

A.   CLAIM 1 - INDEPENDENT

Claim 1 is directed to a system for generating a contract between at least one seller and at least one buyer. Included in such system is a computer for (1) storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract (Specification page 14, line 5 – page 15, line 21; Figure 2), (2) storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules (Specification page 15, line 22 – page 18, line 5; Figure 4), (3) generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract (Specification page 15, line 22 – page 16, line 11; Figure 3), and (4) interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract (Specification page 21, lines 19-23; page 22, lines 1-5; Specification page 25, lines 18-24; Figure 8).

B.   CLAIM 7 - INDEPENDENT

Claim 7 is directed to a method of generating a contract between at least one seller and at least one buyer. The method comprises steps of (1) storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract (Specification page 14, line 5 – page 15, line 21; Figure 2), (2) storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules (Specification page 15, line 22 – page 18, line 5; Figure 4), (3) generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract (Specification page 15, line 22 – page 16, line 11; Figure 3), and (4) interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract (Specification page 21, lines 19-23; page 22, lines 1-5; Specification page 25, lines 18-24; Figure 8).

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C. CLAIM 14 - INDEPENDENT

Claim 14 is directed to a system for conducting a contractual activity over a computer network pursuant to a contract between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions. This activity may be considered to be post-contract processing or fulfillment of the contract itself. Included with such system is (1) a communications interface for receiving information from one of the seller and the buyer, where the communications interface displays selected information based on terms and conditions in the contract (Specification page 10, lines 18-23, page 26, lines 1-10), and (2) a computer for (i) storing the contract terms and conditions, (ii) receiving the information and (iii) referencing the terms and conditions of the contract to process the information (Specification page 23, lines 3-13; Figures 10 and 11).

D. CLAIM 17 - INDEPENDENT

Claim 17 is directed to a method of conducting a contractual activity over a computer network pursuant to a contract between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions. The method comprises steps of (1) storing the contract terms and conditions (Specification page 23, lines 3-13; Figures 10 and 11), (2) receiving information from one of the seller and the buyer via a communications interface, where the communications interface displays selected information based on terms and conditions in the contract (Specification page 10, lines 18-23, page 26, lines 1-10), and (3) referencing the terms and conditions of the contract to process the information (Specification page 23, lines 3-13; Figures 10 and 11).

E. CLAIM 20 - INDEPENDENT

Claim 20 is a computer program product claim comprising code for performing the method recited in Claim 7.

F. CLAIM 27 - INDEPENDENT

Claim 27 is a computer program product claim comprising code for performing the method recited in Claim 17.

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G.   CLAIM 30 - INDEPENDENT

Claim 30 is directed to a system for generating a contract between at least one seller and at least one buyer. Including in such system is (1) at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract (Specification page 14, line 5 – page 15, line 21; Figure 2), (2) at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules (Specification page 15, line 22 – page 18, line 5; Figure 4), (3) means for generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract (Specification page 15, line 22 – page 16, line 11; Figure 3), and (4) means for interlocking the compilation of business rules, the terms and conditions set

and the links to lock the contract (Specification page 21, lines 19-23; page 22, lines 1-5; Specification page 25, lines 18-24; Figure 8).

H.   CLAIM 31 – DEPENDENT WITH MEANS-PLUS-FUNCTION ELEMENT

The claimed means for storing and means for linking is described in the Specification at page 9, lines 13-19.

I.   CLAIM 36 - INDEPENDENT

Claim 36 is directed to a processing system for conducting a contractual activity over a computer network pursuant to a contract between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions. The system comprises (1) a communications interface for receiving information from one of the seller and the buyer, means for storing the contract terms and conditions, where the communications interface displays selected information based on terms and conditions in the contract (Specification page 10, lines 18-23, page 26, lines 1-10), and (2) means for referencing the terms and conditions of the contract to process the information (Specification page 23, lines 3-13; Figures 10 and 11).

J.   CLAIM 39 - INDEPENDENT

Claim 39 is a computer program product claim comprising code for performing the method recited in Claim 7.

K.   CLAIM 46 - INDEPENDENT

Claim 46 is a computer program product claim comprising code for performing the method recited in Claim 17.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   GROUND OF REJECTION 1 (Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48)

Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shkedy (U.S. Pat. No. 6,260, 024) in view of Hoyt et al. (U.S. Pat. No. 6,067,531).

ARGUMENT

A.   GROUND OF REJECTION 1 (Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48)

Generally speaking, the present invention is directed to a synergistic co-action of elements, including a compilation of business rules and a terms and conditions set corresponding to selected rules from the compilation of rules, that are linked and interlocked together, offering component granularity that can easily be modified or adapted to support a plurality of different business models or workflows, and in addition allows flexible access control of the resulting generated entities.

A.1.   Claim 1 (and Claims 7, 20, 30 and 39)

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id.

To establish prima facie obviousness of a claimed invention, <u>all of the claim limitations</u> must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Appellants). *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Appellants will now show that the Examiner has failed to establish a prima facie showing of obviousness, and thus the burden has not shifted to Appellants to rebut an obviousness assertion. In addition, as a prima facie case of obviousness has not been made, the rejection is shown to be improper, per *In re Fine*, Id.

A.1(i).   With respect to Claim 1 (and dependent Claims 2-6), Appellants urge that none of the cited references teach or suggest the claimed feature of "storing at least one terms and conditions set *containing parameters corresponding to selected rules from the compilation of business rules*". In rejecting Claim 1, the Examiner alleges that the cited Shkedy reference teaches "storing set containing parameters (see., abstract, figs 2 and 3, col. 2, lines 1-9, col. 5, lines 32-

67)". The Examiner acknowledges that the cited Shkedy reference fails to explicitly disclose a compilation of business rules or storing terms and conditions. The Examiner then goes on to state that the cited Hoyt reference teaches a client applet that 'enforces' business rules to qualify a contract for expedited approval. This business rule enforcement assertion does not establish a teaching or suggestion by Hoyt of _a terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules_". This claimed feature advantageously provides an ability for logic associated with the business rules to use execution parameters. For example, if the business rules contain logic to determine a discounted price, the corresponding terms and conditions instance in the terms and conditions set would set the discount percentage (Specification page 16, lines 4-7). Claim 1 is thus shown to have been erroneously rejected as there is at least one missing claimed element not taught or suggested by the cited references.

A.1(ii).   Further with respect to Claim 1 (and dependent Claims 2-6), Appellants urge that none of the cited references teach or suggest the claimed feature of _generating links between (1) the compilation of business rules and (2) the terms and conditions set_ to generate specific terms and conditions to be embodied in the contract. This claimed link generating step allows for generation of specific terms and conditions using the business rules, thus advantageously providing a hierarchical relationship where business rules for an entire business can be defined/described in the business rules, which can then be customized to generate specific terms and conditions for a contract (Specification page 16, lines 8-11; FIG. 3).

In rejecting this claimed feature, the Examiner cites Shkedy Col. 5, lines 7-60 and Shkedy FIG. 5 as teaching "generating links between the contract". Appellants show that Claim 1 does not merely recited generating links between the contract, but rather recites that _these generated links are between (i) the compilation of business rules, and (ii) the terms and conditions set_. Thus, the links are between multiple recited items – the business rules and the terms/conditions set. **A mere assertion of links between a contract does not establish links between business rules and a terms and conditions set.** Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1, per _In re Oetiker_, supra. Since a prima facie case of obviousness has not been made, the rejection of Claim 1 is improper, per _In re Fine_,